

Appln. No. 10/708,051  
Docket No. PES-D-03-008/PES-0188

## REMARKS / ARGUMENTS

### Status of Claims

Claims 1-32 are pending in the application. Claims 1-32 stand rejected. Applicant has amended Claims 1-4, 9-14, 19, 20, 22-25, 27-30, and 32, leaving Claims 1-32 for consideration upon entry of the present Amendment.

Applicant respectfully submits that the rejections under 35 U.S.C. §102(b), and 35 U.S.C. §103(a), have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

These amendments and accompanying remarks were not presented earlier because Applicant did not fully appreciate the nature of the Examiner's position until Applicant was advised in more detail of the position by the Final Action paper.

### Rejections Under 35 U.S.C. §102(e)

Claims 1-4, 8-14, 18-25 and 27-32 stand rejected under 35 U.S.C. §102(e) as being anticipated by Czajkowski et al. (U.S. Patent No. 6,503,649, hereinafter Czajkowski et al.).

Applicant traverses this rejection for the following reasons.

Applicant respectfully submits that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, *in a single prior art reference.*" *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the \*\*\* claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Furthermore, the single source must disclose all of the claimed elements "arranged as in the claim." *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir.

Best Available Copy

Appl. No. 10/708,051  
Docket No. PES-D-03-008/PES-0188

1985). Additionally, to establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) MPEP 2112.

Dependent claims inherit all of the limitations of the respective parent claim.

At the outset, and for reasons set forth hereunder, Applicant respectfully submits that it appears the Examiner is using 103 obviousness criteria to support a 102 anticipation rejection. For example, on pages 12-13 of the present office action (Paper No. 2), the Examiner states that “a motherboard is *implicit*”, that “Fig. 1 or 2 serve as an adequate *suggestion*”, and that “*if the structure were actually present*”, to allege anticipation, which applicant submits is inappropriate under the circumstances. As such, Applicant respectfully requests that the Examiner withdraw the anticipation rejection and the finality of the present Office Action.

**Regarding Independent Claim 1 more specifically**

Applicant has amended Claim 1 to now recite, inter alia, “...a plurality of interchangeable power converter modules, each power converter module disposed upon a single circuit board; and a first expandable motherboard...”

No new matter has been added by these amendments as antecedent support may be found in the specification as originally filed, such as at Paragraph [0022] for example.

In [paper 2, p. 12], the examiner asserts that “a motherboard is *implicit*”, and “the dashed lines of Fig. 1 or 2 serve as an adequate suggestion as to how to divide/implement the motherboard” (emphasis added). Further, in [paper 2, p. 12-13] the Examiner explains “The examiner points out that *if the structure were* actually present, then it would be expressly present, thus forgoing the need to use implicit reasoning.” (emphasis added).

Applicant respectfully submits that Czajkowski lacks an explicit disclosure of the claimed “...plurality of interchangeable power converter modules, each power converter

Best Available Copy

Appln. No. 10/708,051  
Docket No. PES-D-03-008/PES-0188

module disposed upon a single circuit board; and a first expandable motherboard configured to receive the plurality of interchangeable power converter modules.” Further, Applicant finds that the dashed lines of Fig. 1 or 2 include a fuel cell (30), a DC Storage (36), and a DC to AC Converter (40). If Applicant assumes, as suggested by the Examiner, that such dashed lines do provide a division of component for installation onto a motherboard, such a division would include a fuel cell, battery, and power converter, but not the claimed “...interchangeable power converter modules, each power converter module disposed upon a single circuit board.”

Accordingly, Applicant submits that Czajkowski does not disclose each and every claim element arranged as in the claim, and absent anticipatory disclosure in Czajkowski of each and every element of the claimed invention arranged as in the claim, Czajkowski cannot be anticipatory. Applicant respectfully requests that Examiner withdraw this anticipation rejection, and the finality of the present Office Action.

**Regarding Independent Claim 11 more specifically**

Applicant submits that for at least the same reasons as set forth above, Czajkowski does not disclose each and every claim element arranged as in Claim 11.

Applicant has amended Claim 11 to now recite, inter alia “...a plurality of interchangeable power converter modules, each power converter module disposed upon a single circuit board; and a first expandable motherboard...”

Applicant respectfully submits that Czajkowski lacks an explicit disclosure of the claimed “...plurality of interchangeable power converter modules, each power converter module disposed upon a single circuit board, and a first expandable motherboard configured to receive the plurality of interchangeable power converter modules.”

Accordingly, Applicant submits that Czajkowski does not disclose each and every claim element arranged as in the claim, and absent anticipatory disclosure in Czajkowski of each and every element of the claimed invention arranged as in the claim, Czajkowski cannot be anticipatory. Applicant respectfully requests that Examiner withdraw this anticipation rejection, and the finality of the present Office Action.

Appl. No. 10/708,051  
Docket No. PES-D-03-008/PES-0188

**Regarding Independent Claim 22 more specifically**

Applicant submits that for at least the same reasons as set forth above, Czajkowski does not disclose each and every claim element arranged as in Claim 22.

Applicant has amended Claim 22 to now recite, inter alia, "...configuring the first power converter such that its power rating is adjustable by changing a number of interchangeable power converter modules, each power converter module disposed upon a single circuit board and attached to a first expandable motherboard of the first power converter".

Applicant respectfully submits that Czajkowski lacks an explicit disclosure of the claimed "...configuring the first power converter such that its power rating is adjustable by changing a number of interchangeable power converter modules, each power converter module disposed upon a single circuit board and attached to a first expandable motherboard of the first power converter".

Accordingly, Applicant submits that Czajkowski does not disclose each and every claim element arranged as in the claim, and absent anticipatory disclosure in Czajkowski of each and every element of the claimed invention arranged as in the claim, Czajkowski cannot be anticipatory. Applicant respectfully requests that Examiner withdraw this anticipation rejection, and the finality of the present Office Action.

**Regarding Dependent Claim 32 more specifically**

Applicant has amended Claim 32 to now recite "...the plurality of interchangeable power converter modules receive a generated grid input voltage from the first motherboard, and provide a programmable output voltage in parallel to the electrochemical cell". No new matter has been added by this amendment as antecedent support may be found in the specification as originally filed, such as at Paragraph [0019] for example.

In alleging anticipation, the Examiner asserts "Czajkowski discloses the plurality of interchangeable power converter modules receive input voltage from the first motherboard [see statement concerning motherboard in claim 1 and in arguments below. The converters receive power from the fuel cells, which can be on its own

Appin. No. 10/708,051  
Docket No. PES-D-03-008/PES-0188

motherboard/chassis or combined with that of the converter], and provide programmable output voltage in parallel to the electrochemical cell [the connection between the converters and the fuel cell is parallel, the voltage is programmable through the action of the controller 20 in Fig. 1-col. 6 lines 56-68 and col. 7 lines 1-6].” Instant Office Action, page 8.

Contrary to the claimed invention, Applicant finds Czajkowski to disclose that “a free-standing local generation system ... that simulates the power reliability of a power grid, but generated within the physical boundaries of a service zone ...[and] replaces the multi-feed network of the commercial power grid...”. [Czajkowski, col. 4 lines 19-25].

In view of the foregoing, Applicant respectfully submits that Czajkowski is absent disclosure of the claimed “...the plurality of interchangeable power converter modules receive a generated grid input voltage from the first motherboard, and provide a programmable output voltage in parallel to the electrochemical cell”.

Accordingly, Applicant submits that Czajkowski does not disclose each and every claim element arranged as in the claim, and absent anticipatory disclosure in Czajkowski of each and every element of the claimed invention arranged as in the claim, Czajkowski cannot be anticipatory.

**Regarding Dependent Claim 4 more specifically**

Applicant has amended Claim 4 to additionally claim previously disclosed but unclaimed subject matter. No new matter has been added as antecedent support may be found in the application as originally filed, such as at Paragraph [0024], for example.

For at least the reasons set forth above regarding the allowability of Claim 1, Applicant submits that Claim 4 is directed to allowable subject matter and respectfully requests entry and notice of allowance thereof.

Applicant respectfully requests that the finality of the present office action be withdrawn to permit entry of the amendments made herein.

Best Available Copy

Appln. No. 10/708,051  
Docket No. PES-D-03-008/PES-0188

In view of the amendment and foregoing remarks, Applicant submits that Czajkowski does not disclose each and every element of the claimed invention arranged as claimed and therefore cannot be anticipatory.

Additionally, Applicant respectfully submits that an anticipation rejection based on implied existence (that is not necessarily present in the prior art), suggested adequacy, and possible existence ("if the structure were actually present"), is inappropriate grounds for an anticipation rejection.

Accordingly, Applicant respectfully submits that the Examiner's rejections under 35 U.S.C. §102(b) have been traversed, requests that the Examiner reconsider and withdraw these rejections, and respectfully requests that the finality of the present office action be withdrawn to permit entry of the amendments made herein.

#### Rejections Under 35 U.S.C. §103(a)

Claims 5-7, 15-17 and 26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Czajkowski et al. (U.S. Patent No. 6,503,649) in view of Nomura (U.S. Publication No. 2001/0012207, hereinafter Nomura).

Applicant traverses these rejections for the following reasons.

Applicant respectfully submits that the obviousness rejection based on the References is improper as the References fail to teach or suggest each and every element of the instant invention in such a manner as to perform as the claimed invention performs. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03.

Dependent claims inherit all of the limitations of the respective parent claim and any intervening claim.

The Examiner acknowledges that Czajkowski is deficient in anticipating the claimed invention, and looks to Nomura to cure these deficiencies.

Appl. No. 10/708,051  
Docket No. PES-D-03-008/PES-0188

Claims 5-7, 15-17 and 26 are dependent claims. In view of Applicant's remarks set forth above regarding the allowability of the parent claim over Czajkowski, Applicant submits that Claims 5-7, 15-17 and 26 are allowable at least for the reason that they depend from an allowable claim. Accordingly, Applicant submits that Claims 6, 7, 16, and 17 are now allowable, and respectfully requests notice of allowance thereof.

In view of the foregoing, Applicant submits that the References fail to teach or suggest each and every element of the claimed invention and are therefore wholly inadequate in their teaching of the claimed invention as a whole, and fail to motivate one skilled in the art to do what the patent Applicant has done, and therefore cannot properly be used to establish a prima facie case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of all rejections under 35 U.S.C. §103(a), which Applicant considers to be traversed.

Applicant has amended the claims for presentation in a better form that more clearly reflects Applicant's invention. In light of the foregoing remarks and amendments, Applicant respectfully submits that the proposed amendments and arguments comply with 37 C.F.R. §1.116 and should therefore be entered, and with their entry that the Examiner's rejections under 35 U.S.C. §102(b), and 35 U.S.C. §103(a), have been traversed, and that the application is now in condition for allowance. Such action is therefore respectfully requested.

As set forth above, and for reasons already presented, Applicant respectfully requests that the finality of the present office action be withdrawn to permit entry of the amendments made herein.

Best Available Copy

Appln. No. 10/708,051  
Docket No. PES-D-03-008/PES-0188

The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 06-1130.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above-identified Deposit Account.

Respectfully submitted,

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